

## **RESPONSE TO THE ELECTION REQUIREMENT**

### **A. The Election Requirement**

In the Office Action dated March 27, 2007, the Examiner has requested an election among the following species:

Embodiment I, directed to a burner with a Venturi tube separate from the burner body, attached to the burner body by a tubular sleeve;

Embodiment II, directed to a burner having Venturi tube consisting of two half shells that are integral with the half shells of the burner body and a tab for mounting an igniter; and

Embodiment III, directed to a burner with a Venturi tube having a truncated end and a tubular joint to connect the Venturi tube to the burner body.

The Examiner has further held that claim 1 is generic.

### **B. Election**

Applicant hereby elects embodiment II, which is readable on claims 1-49 and 55-68. This election is made with traverse, for the reasons detailed in the following section.

Applicant expressly reserves the right to rejoin the non-elected claims in the application, upon allowance of at least some of the elected claims.

### **C. Traverse**

The requirement for election is respectfully traversed on the grounds that the various species referred to in the Office Action are simply different embodiments of the same invention. Applicant has presented a generic invention with a generic claim and set forth a number of embodiments falling within the generic invention. It is submitted that 37 CFR 1.141 points out that distinct inventions may not form a single general inventive concept and may not be claimed in one application. However, the rule states that more than one species of an invention may be specifically claimed in different claims in one application, provided the application also includes an allowable generic claim and all the claims to species in excess of one are written in dependent

form or otherwise include all limitations of the generic claim. It is submitted that is precisely the situation in this application. Therefore, the requirement for election is improper.

The Examiner has held that no unifying technical feature is present among the different embodiments, on the ground that the burner of generic claim 1 is known in the art. Applicant respectfully submits that Applicant has not yet been provided with the opportunity to argue why claim 1 is not anticipated, or to amend claim 1 based on rejection by the Examiner, so to make claim 1 allowable while retaining a unifying technical feature.

The Examiner's position set forth in the Office Action, that Applicant's traversal of the election requirement may be considered an admission in a subsequent prior art rejection that one species is obvious in view of the other because different embodiments of the same invention are presented, is believed improper and contrary to the law. It is believed clear that Applicant's teaching of equivalency in Applicant's own specification is not available to the Examiner as an admission in a rejection under 35 USCA 103. The equivalence must be disclosed in the prior art. Any disclosure of equivalence in Applicant's specification cannot be used by the Examiner to support his rejection. *In re Ruff et al.*, 256 Fed. 2d. 590, 118 USPQ 340. Therefore, this portion of the Action is an improper use of Applicant's disclosure and Applicant's traversal of this election requirement is not available for use against him in future prosecution of this application.

#### **D. Conclusion**

In view of the amendments and remarks submitted herein, Applicant submits that the present application is now in condition for examination.

Dated: April 26, 2007

Respectfully submitted,

/Franco A. Serafini/

Franco A. Serafini, Registration No. 52,207

Attorney for Applicant

Tel.: (858) 456-2898

Fax: (858) 225-3920

E-Mail: fserafini@themisipc.com

THEMIS INTELLECTUAL PROPERTY COUNSEL  
7660 Fay Avenue, Suite H378  
La Jolla, CA 92037